

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barsanti et al.
Title: BENZIMIDAZOLE QUINOLINONES AND
USES THEREOF
Appl. No.: 10/644,055
Filing Date: 8/19/2003
Patent No.: 7470709
Grant Date: 12/30/2008
Examiner: D. Margaret M. Seaman
Art Unit: 1625
Confirmation Number: 5144

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 12/30/2008 as U.S. Patent No. 7,470,709.

The Patent Office determined that the patent was entitled to 392 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA

statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 811 days PTA, as shown on the attached sheets, which show the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheets detail the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 1021 days

(b) Total Applicant delay: 210 days

Final PTA Determination: 811 days

Applicants therefore respectfully request that the patent be accorded 811 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Dated: February 25, 2009

By Joseph P. Meara

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Docket Number: 072121-0307
 Application Number: 10/644055
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	08/19/2003	0		
Edit Delete	Notice to File Missing Parts	11/17/2003	90		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	11/17/2003	90		
Edit Delete	Response to Notice to File Missing Parts	12/11/2003	114		
Edit Delete	Preliminary Amendment under 1.704(c)(6) Received at PTO	12/15/2003	118		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	12/22/2003	125		
Edit Delete	Application Is Now Complete	01/30/2004	164		
	14 month From Application date	10/19/2004	427		
Edit Delete	Preliminary Amendment NOT falling under 1.704 (c)(6) Received at PTO	12/15/2005	849		
Edit Delete	Restriction Requirement	06/13/2006	1,029	602	
Edit Delete	Restriction Requirement Response Received at PTO	07/10/2006	1,056		
	3 Year Period Starts	08/19/2006	1,096		
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Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/16/2007	1,305		88
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	Final Office Action + 3 months	09/11/2007	1,484		
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	3 Year Period Stopped	10/12/2007	1,515	419	
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Edit Delete	Issue Fee Paid	11/12/2008	1,912		
Edit Delete	Patent Grant Date	12/30/2008	1,960		
	Totals:	1,021		210	
	PTA:		811		



Version: 3.02.05

LOGIN: **Sharon Dudley**

IP: 10.24.4.200

Foley & Lardner LLP